



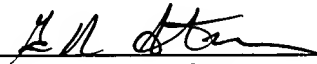
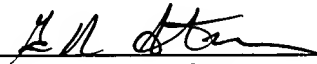
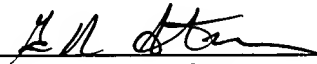
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)											
		991094											
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number	Filed											
	09/406,798	September 28, 1999											
	First Named Inventor												
	Hirosi TUNODA												
	Art Unit	Examiner											
	2622	Justin P. Misleh											
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td></td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Signature George N. Stevens</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 36,938</td><td>Typed or printed name (202) 659-2930</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>Telephone number May 25, 2007</td></tr><tr><td></td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				<input type="checkbox"/> applicant/inventor.		<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature George N. Stevens	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 36,938	Typed or printed name (202) 659-2930	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number May 25, 2007		Date
<input type="checkbox"/> applicant/inventor.													
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<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number May 25, 2007												
	Date												

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of: **Hirosi TUNODA**

Group Art Unit: **2622**

Serial No.: **09/406,798**

Examiner: **Justin P. Misleh**

Filed: **September 28, 1999**

P.T.O. Confirmation No.: 1948

For: **METHOD FOR RECORDING IMAGE DATA IN RECORDING MEDIUM
THROUGH STORAGE MEDIUM AND IMAGE PICKUP APPARATUS**

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: May 25, 2007

Sir:

The following is a brief statement stating the reasons for this Pre-Appeal Brief Request for Review. The Appellant is of the opinion that a clear case of factual and legal error has occurred during the prosecution of this case.

In the Office Action mailed January 26, 2007 the Examiner rejected claims 1, 3, 4, 7, 9, 10, 13, 15, 16, 19, 21, 22, 24, 25 and 27 under 35 U.S.C. §102(e) as being anticipated by Fukushima et al.

The test for anticipation under 35 U.S.C. §102 was set forth by the Federal Circuit in **Verdegaal Bros. v. Union Oil Co. of California**, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). In the **Verdegaal** case, the Court indicated that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." **Id.** The **Richardson** Court further indicated that "[t]he identical invention must

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May 25, 2007

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be shown in as complete detail as contained in the claim." **Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1990).**

The prior art, Fukushima et al., fails to expressly or inherently describe a key features recited in all the independent claims. Specifically, Fukushima et al. fails to expressly or inherently disclose, as exemplified by claim 1,

"wherein after starting the step of recording, the step of storing each piece of image data continuously obtained by the image pickup operation in the storage medium and the step of recording each piece of the image data being stored in the storage medium into the non-volatile recording medium **are performed continuously, in parallel and irrespective of the amount of the image data stored** in the storage medium during the image pickup operation without pausing, interrupting or reducing the rate of recording the image data." (Emphasis Added)

It is the Appellant's position that the hard drive used in Fukushima et al. cannot be kept operating continuously and in parallel while both storing and recording image data due to the power consumption required by the hard drive and therefore must be switched to a power save mode or a stand-by mode (See column 6, lines 54-63 of Fukushima et al.).

The Examiner apparently agreed with the Appellant regarding the operation of the Fukushima et al. at one time during the prosecution history of the present application. On page 7, lines 4-8 of the Office Action mailed February 8, 2006 the Examiner states,

"The Examiner acknowledges the Fukushima et al. does not teach constantly recording the image data from the buffer memory (6) to the hard drive (8), rather teaches continuously capturing and storing images and recording bursts of image of image data from the buffer memory (6) to hard drive (8) after certain requirements are met." (Emphasis Added)

Further, during an in-person interview which took place on May 3, 2007 with the Examiner's representative, the Examiner indicated that due to the long lead time required to bring a hard drive to proper rotational speed it would not be feasible to stop the hard drive and restart it to continue recording and therefore "inferred" that, once started, the hard drive (8) of Fukushima et al. continued operating and thus could store and record image data continuously and in parallel.

However, as previously discussed, the Fukushima et al. invention discloses a power save mode or a stand-by mode (See column 6, lines 54-63 of Fukushima et al.). It takes approximately several hundred milliseconds to go from the power save mode to the active mode. Further, Fukushima et al. states in column 9, lines 49-56,

"As is known, when the hard disk in the hard disk unit is to be initially rotated, control parameters such as rotational servo data for the hard disk are varied according to the state of the hard disk. As a result, there is a case where the start-up time of the hard disk during the initial rotating operation thereof becomes longer than that of the hard disk during the second rotating operation ..."

Therefore, in Fukushima et al. second and subsequent startups of the hard drive takes less time than the initial startup and the hard drive (8) can thus be placed in standby mode to save power.

Further, and simply stated, there is no description or suggestion in Fukushima et al. that image data may be stored and recorded continuously and in parallel as recited in the independent claims. On page 3, lines 1-4 of the Office Action mailed January 26, 2007, the Examiner asserts that "Fukushima et al. disclose an image pickup device that is capable of "stably executing continuous recording of an image signal by means of a simple arrangement with a small power consumption" (see column 3, lines 39-43)". However, simply because the term "continuous" is used in the

reference, there is no suggestion that image data may be stored in a storage medium and then recorded in a non-volatile recording medium continuously and in parallel as recited in the independent claims. No such disclosure is provided by Fukushima et al.

Further, Fukushima et al. fails to disclose recording and storing of image data takes place “irrespective of the amount of the image data stored in the storage medium during the image pickup operation” as recited in the independent claims. Fukushima et al. states in column 3, lines 44-54,

“To achieve the above-described objects, according to one aspect of the present invention, there is provided an image signal processing apparatus for processing an image signal, which comprises first storage means for temporarily storing image data inputted thereinto and outputting the image data, second storage means having a moving element for storing in a recording medium the image data outputted from the first storage means, and operation controlling means for moving the moving element of the second storage means **after a predetermined amount of image data is stored in the first storage means.**” (Emphasis Added)

Still further, Figure 2 of Fukushima et al. indicates that “DECREMENT RECCNT” is present in step 16, hence “TRANSMIT IMAGE DATA TO HARD DRIVE” in step 15 is not limited to transmittance of the entire image data stored in the memory unit at once. However, since transmittance to a hard drive is always carried out in step 11 based on the comparison result of RECCNT and CTH. Therefore, Fukushima et al. fails to disclose the storing in a storage medium and the recording in a non-volatile recording medium recording irrespective of the amount of the image data stored in the storage medium as recited in the independent claims.

Therefore, reversal of the rejection of claims 1, 3, 4, 7, 9, 10, 13, 15, 16, 19, 21, 22, 24, 25 and 27 under 35 U.S.C. §102(e) as being anticipated by Fukushima et al. is respectfully requested.

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Respectfully submitted,

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